•• REMARKS ••

The Official Action of November 22, 2002 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment, non-elected claims 3-8 have been canceled without prejudice or disclaimer. Applicant reserves his right to seek patent protection of the subject matter of claims 3-8 by filing one or more divisional applications during the pendency of the present application.

Claims 1 and 2 are pending in the present application.

Claims 1 and 2 stand rejected under 35 U.S.C. §103(a) as being unpatentable over International Patent Publication No. WO 94/14607 to BOICH in view of European Patent Application No EP 1 066 957 to Kobayashi et al.

For the reasons set forth below, it is submitted that each of the pending claims are allowable over the prior art relied upon by the Examiner and therefore, the outstanding rejection of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner states that BOICH describes a multi-layer surface panel which "corresponds to the claimed composite sheet." The Examiner has relied upon BOICH as disclosing at least one elastic layer of a uniform film or foil which corresponds to the claimed elastically stretchable layer with upper and lower surfaces. The Examiner states that BOICH describes at least one inelastic fiber or filament layer joined at spaced points which correspond to the claimed invention which are joined or bonded together intermittently.

The Examiner has relied upon Kobayashi et al. as describing that the upper and lower layers of a composite sheet may be bonded orthogonally, even though "non-preferred."

Although not expressly stated in the Office Action, it appears that the Examiner is proposing to combine the teachings of BOICH and Kobayashi et al. to develop a multi-layer surface panel having at least one elastic layer of a uniform film or foil and at least one inelastic fiber or filament layer which are joined or bonded together intermittently in an orthogonal manner.

The Examiner does concede that "WO'607 differs from the claimed invention because it is silent about the tensile strength ratio of the elastic layer to the inelastic layer."

The Examiner nevertheless takes the position that:

> It would have been obvious....to optimize the ratio of the tensile strengths in the first direction to the second direction motivated with the expectation that this would improve softness since tensile is the ability of a fiber, yarn or fabric to resist breaking under strain, it has been held that discovering an optimum value involves only routine skill in this art, In re Boesch, 617 F.2d, 272 205 USPQ 215 (CCPA 1980).

There seems to be some confusion in the Examiner's reference to "the tensile strength ratio of the elastic layer to the inelastic layer" and the "the ratio of the tensile strengths in the first direction to the second direction." Applicant's claim 1 encompasses the latter.

Applicant's independent claim 1 recites that:

> ...said inelastically stretchable continuous fibers of said inelastically stretchable fibrous layer being oriented substantially in said one direction so that a tensile strength S_1 of said composite sheet in said first direction and a tensile strength S_2 of said composite sheet in said second direction define a ratio S_1/S_2 of 3.0 or higher.

As claimed, it is the orientation of the inelastically stretchable continuous fibers in substantially one direction which provides the tensile strength ratio in the first and second directions of applicant's composite sheet.

That is, it is the structural arrangement of the inelastically stretchable continuous fibers that produces the claimed tensile strength ratio.

The prior art relied upon by the Examiner does not teach a composite sheet that includes an inelastically stretchable fibrous layer in which inelastically stretchable continuous fibers are oriented substantially in one direction.

That is, the prior art does not teach applicant's claimed structure.

The Examiner's position that "It would have been obvious....to optimize the ratio of the tensile strengths in the first direction to the second direction..." fails to properly address the structural limitations of applicant's claim 1, let alone find support in any prior art teaching.

The Examiner has cited *In re Boesch* (617 F.2d 272, 205 USPQ 215 (CCPA)) as holding that "discovering an optimum value involves only routine skill in this art."

The Examiner is invited to review the Board of Patent Appeals and Interferences opinion in *Ex parte Roland Barth* (Appeal No. 1998-0982; Application No. 08/399,715) (http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd980982.pdf). In *Barth*, the Board cited *Boesch*, noting that the optimization referred to in *Boesch* is the optimization of a known parameter or "effective variable in a known process." The Board stated that "...in all authorities known to us, the optimization relates to a range or variable."

In the present situation, the Examiner has not relied upon any prior art that teaches any specific manner of adjusting or optimizing tensile strength according to the manner of applicant's invention.

Accordingly, the holding in *Boesch* is not applicable to the present situation and the basis upon which the Examiner has found applicant's claim invention obvious under 35 U.S.C. § is therefore unsupported.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsidcration is requested.

If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Marked-Up Copy of the Claims
As Amended on February 24, 2003

Non-elected claims 3-8 have been canceled without prejudice or disclaimer.